

This Opinion is Not a
Precedent of the TTAB

Mailed: August 14, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Marta Antonia Rivera Diaz

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Serial Nos. 88195150 and 88195194¹

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Marsha G. Gentner of Dykema Gossett PLLC,
for Marta Antonia Rivera Diaz.

Sean O’Tormey, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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Before Lykos, Shaw and Johnson,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

¹ On March 30, 2020, the Board granted the Examining Attorney’s motion to consolidate the above referenced appeals. 7 TTABVUE 1. Unless otherwise noted, Trademark Status & Document Retrieval (“TSDR”) record citations are to Serial No. 88195150, the parent case.

Marta Antonia Rivera Diaz (“Applicant”) seeks registration on the Principal Register of the standard character mark² SENSE & EDIBILITY and the composite mark³ displayed below



for “providing a website featuring information in the field of recipes and cooking” in International Class 43.⁴

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s applied-for marks so resemble the registered standard character mark EDIBILITY on the Principal Register for “catering services; food preparation services” in International Class 43, that, when used on or in connection with Applicant’s identified services, they are likely to cause confusion or mistake or to deceive.⁵

² Applicant’s mark appears on the drawing page as “Sense and Edibility” but retains a claim as to standard characters and not special form. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a); *see also In re Calphalon Corp.*, 122 USPQ2d 1153, 1158-61 (TTAB2017) (applicant’s amendment of mark from SHARPIN to SharpIn did not transform mark from standard character to special form). Our references to Applicant’s mark in this opinion in all uppercase letters reflects the fact that a term registered as a mark in standard character format is not limited to any particular font style, size, or color.

³ The description of the composite mark is as follows: “The mark consists of the wording SENSE and EDIBILITY in dark brown, with a light green stylized ampersand symbol with wheat at the upper right and lower left points appearing between the words. The color white is meant as background and is not claimed as part of the mark.” The colors light green and dark brown are claimed as features of the mark.

⁴ Application Serial Nos. 88195150 and 88195194, filed November 15, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The applications allege September 26, 2016 as the date of first use anywhere and December 12, 2016 as the date of first use in commerce.

⁵ Registration No. 3860624, registered October 12, 2010; Sections 8 and 15 affidavits accepted and acknowledged.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the requests for reconsideration, the appeals were resumed. The case is fully briefed.

For the reasons set forth below, we reverse the refusals.

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 26 USPQ2d at 1688 (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

Applicant’s and Registrant’s services are different, but the evidence of record shows it is not uncommon for catering and food preparation services to also provide online recipes as part of their website advertising.⁶ In addition, while we agree with Applicant that prospective clients seeking catering services for special events such as weddings are likely to exercise a relatively high degree of care, because Applicant’s

⁶ See excerpts from third-party websites (for example, www.customercatering.net, www.rania.com, and www.championshipcatering.com) submitted with February 20, 2019 Office Action, pp. 2-13 and October 8, 2019 Office Action pp. 2-40.

and Registrant's services are unrestricted as to consumer or price, we must presume that the services are offered to the least sophisticated consumer. *See In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Thus, the second and fourth *DuPont* factors weigh in favor of finding a likelihood of confusion.

Applicant submitted only minimal evidence of third-party registrations for EDIBLE-formative marks in connection with food services in an effort to show that the cited mark EDIBILITY has some conceptual weakness as suggestive of catering and food preparation services.⁷ *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (third-party registrations alone may be relevant, in the manner of dictionary definitions, "to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak."). *See also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). The dictionary definition of "edibility" as "the property of being fit to eat" and "fit to be eaten as food; eatable"⁸ constitutes stronger evidence that the cited mark is suggestive and therefore inherently weak as applied to "catering services; food

⁷ *See* Registration No. 5745544 (EDIBLE BEATS for "restaurant services") and Registration No. 4924206 (EDIBLE PASSPORT for "restaurant services; fast food restaurant services; restaurant services provided via mobile food trucks") submitted with December 18, 2019 Request for Reconsideration, pp. 33-48. The remaining third-party registrations submitted by Applicant were not relevant.

⁸ Entries for the "edibility" from The Free Dictionary and Dictionary.com submitted with December 18, 2019 Request for Reconsideration. The Google search engine summary results are of probative value here because they display the cited definitions. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.03 (2020).

preparation services.” Nonetheless, we accord the cited registration which is on the Principal Register without a claim of acquired distinctiveness under Section 2(f) the appropriate scope of protection. *See* Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

That being said, a single *DuPont* factor may be dispositive, and when we compare the marks, we find that to be the case here. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The first *DuPont* likelihood of confusion factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). When comparing the marks, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958,

1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

The Examining Attorney takes the position that EDIBILITY constitutes the dominant element in Applicant's marks, and that because Applicant's marks share this term with the cited mark, the marks are confusingly similar. In making this argument, the Examining Attorney emphasizes that EDIBILITY forms the entirety of the cited mark. *See e.g., Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) ("BENGAL" for gin and "BENGAL LANCER" for nonalcoholic club soda, quinine water and ginger ale).

Applicant counters that her marks are a play on the "famous literary work [by Jane Austen] (and movie and television series)" *Sense and Sensibility*, and it is this play on words, as a whole, which will be (and is) the commercial impression of Applicant's mark, not merely, or even predominantly, "edibility."⁹ In support thereof, Applicant submitted the following evidence regarding Jane Austen's novel *Sense and Sensibility* and the 1995 film adaptation. We highlight the following:

WIKIPEDIA entry for Jane Austin's novel, Sense and Sensibility:¹⁰

Sense and Sensibility is a novel by Jane Austen, published in 1811. It was published anonymously; *By A Lady* appears on the title page where the author's name might have been. It tells the story of the Dashwood sisters, Elinor (age 19) and Marianne (age 16 1/2) as they come of age. They have an older half-brother, John, and a younger sister, Margaret, 13.

⁹ Applicant's Brief, p. 17; 4 TTABVUE 18.

¹⁰ April 29, 2019 Response to Office Action, p. 2.

The novel follows the three Dashwood sisters as they must move with their widowed mother from the estate on which they grew up, Norland Park. Because Norland is passed down to John, the product of Mr. Dashwood's first marriage, and his young son, the four Dashwood women need to look for a new home. They have the opportunity to rent a modest home, Barton Cottage, on the property of a distant relative, Sir John Middleton. There they experience love, romance, and heartbreak. The novel is likely set in southwest England, London, and Sussex between 1792 and 1797.

The novel, which sold out its first print run of 750 copies in the middle of 1813, marked a success for its author. It had a second print run later that year. It was the first Austen title to be republished in England after her death, and the first illustrated Austen produced in Britain, in Richard Bentley's Standard Novels series of 1833. The novel continued in publication through the 19th, 20th and early 21st centuries and has many times been illustrated, excerpted, abridged, and adapted for stage and film.

WIKIPEDIA entry for the 1995 film, *Sense and Sensibility*:¹¹

Sense and Sensibility is a 1995 British period drama film directed by Ang Lee and based on Jane Austen's 1811 novel of the same name. Emma Thompson wrote the screenplay and stars as Elinor Dashwood, while Kate Winslet plays Elinor's younger sister Marianne. The story follows the Dashwood sisters, members of a wealthy English family of landed gentry, as they must deal with circumstances of sudden destitution. They are forced to seek financial security through marriage. Hugh Grant and Alan Rickman play their respective suitors. The film was released on December 13, 1995, in the United States.

...

Thompson's screenplay exaggerated the Dashwood family's wealth to make their later scenes of poverty more apparent to modern audiences. It also altered the traits of the male leads to make them more appealing to contemporary viewers. Elinor and Marianne's different characteristics

¹¹ *Id.* at 18-33.

were emphasized through imagery and invented scenes. Lee was selected as director, both due to his work in the 1993 film *The Wedding Banquet* and because Doran believed he would help the film appeal to a wider audience. Lee was given a budget of \$16 million.

A commercial success, earning \$135 million worldwide, the film garnered overwhelmingly positive reviews upon release and received many accolades, including three awards and eleven nominations at the 1995 British Academy Film Awards. It earned seven Academy Awards nominations, including for Best Picture and Best Actress. Thompson received the award for Best Adapted Screenplay, becoming the only person to have won Academy Awards for both acting and screenwriting. *Sense and Sensibility* contributed to a resurgence in popularity for Austen's works, and has led to many more productions in similar genres. It persists in being recognized as one of the best Austen adaptations of all time.

...

By the end of its American release, *Sense and Sensibility* had been watched by more than eight million people, garnering an "impressive" total domestic gross of \$43,182,776.

On the basis of Austen's reputation as a serious author, the producers were able to rely on high-brow publications to help market their film. Near the time of its US release, large spreads in *The New York Review of Books*, *Vanity Fair*, *Film Comment*, and other media outlets featured columns on Lee's production. In late December, *Time* magazine declared it and *Persuasion* to be the best films of 1995. Andrew Higson referred to all this media exposure as a "marketing coup" because it meant the film "was reaching one of its target audiences." ... Signet Publishing in the US printed 250,000 copies instead of the typical 10,000 a year; actress Julie Christie read the novel in an audiobook released by Penguin Audiobooks. *Sense and Sensibility* increased dramatically in terms of its book sales, ultimately hitting tenth place on *The New York Times* Best Seller list for paperbacks in February 1996.

Sense and Sensibility has maintained its popularity into the twenty-first century. In 2004, Louise Flavin referred to the 1995 film as “the most popular of the Austen film adaptations,” and in 2008, *The Independent* ranked it as the third-best Austen adaptation of all-time ...

The year 1995 saw a resurgence of popularity for Austen’s works, as *Sense and Sensibility* and the serial *Pride and Prejudice* both rocketed

Applicant also made of record a print out from the website, www.imdb.com, for the 2008 television series *Sense and Sensibility* available for streaming on Prime Video.¹²

The Examining Attorney questions whether U.S. consumers will recognize Applicant’s mark as a homage to Austen’s work. He postulates that “[a]ssuming arguendo, that consumers will even understand the applicant’s play on words and reference to the literary work, this only serves to highlight EDIBILITY in the applied-for marks. This play on words actually makes EDIBILITY the dominant feature of the applied-for marks. ... because it is the feature of the marks that will leave the greatest lasting impression on consumers as it is the only literal element in the marks that is distinguishable from the inspiration, *Sense and Sensibility*.”¹³

While the marks do share the term “edibility,” the distinctions in connotation and commercial impression are significant. Based on the record evidence, we find that consumers are likely to perceive Applicant’s marks as a clever pun. Applicant’s marks, by replacing the word “sensibility” in the title *Sense and Sensibility* with the word rhyming word “edibility,” result in a play on words when considered in relation

¹² *Id.* at 43.

¹³ Examining Attorney’s Brief, 8 TTABVUE 7.

to the identified services of “providing a website featuring information in the field of recipes and cooking.” Although the novel *Sense and Sensibility* was first published in 1811 in England, it has remained in print in the United States over the course of three centuries and has been the subject of film, television, and stage adaptations for U.S. audiences, including the critically acclaimed 1995 screen adaptation noted above viewed by over 8 million people in U.S. theaters. The film’s success resulted in a resurgence in the novel’s popularity and a substantial increase in U.S. sales. Thus, contrary to the Examining Attorney’s assertion, *Sense and Sensibility* is well-recognized as a book and movie title amongst U.S. consumers. For this reason, we disagree with the Examining Attorney’s finding that EDIBILITY is the dominant element in Applicant’s standard character and composite marks. Instead, no single word dominates because SENSE & SENSIBILITY as a whole functions a unitary phrase. *Cf. Ex parte Mooresville Mills, Inc.*, 102 USPQ 440, 441 (Comm’r Pats. 1954) (a unitary phrase has “some degree of ingenuity in its phraseology as used in connection with the goods; or [say] something a little different from what might be expected to be said about the product; or [say] an expected thing in an unexpected way.”).

Our determination is confirmed by the evidence in the record of direct consumer recognition of Applicant’s SENSE & EDIBILITY marks as a tribute to Austen’s novel. Note the following text message exchanges between Applicant and two prospective clients:¹⁴

¹⁴ April 29, 2019 Response to Office Action, p. 48-49.

Exchange with “Lauren”:

Client: Also, “sense and edibility” is literally just ... the best ever. I’m a huge Jane Austen fan so that made me smile.

Applicant: Aww, thanks so much! I tried to pay homage to Jane Austen since she was my mother’s favorite author too.

Exchange with “ginge...”

Client: Oh my god! But how FUN is your name!

Applicant: Thank you!! I named my blog to honor my mother’s favorite author and book ... of course with a culinary play on words.

Client: It just totally killed me. I was sitting there going OH MY GOD THAT IS SO CLEVER! Out loud and all, ha ha.

Applicant: I love it!!

Thus the primary connotation and commercial impression of Applicant’s standard character and composite marks call to mind the well-known novel and film.

By contrast, the cited mark EDIBILITY, standing alone, is entirely devoid of any hint or reference to the Jane Austen novel, film adaptation or television series. Without the words “sense and,” the cited mark takes on the ordinary meaning of the word “edibility” as something to eat. Thus, while Applicant’s mark projects the unique commercial impression of a clever reference to a well-known literary work and film, Registrant’s mark is an ordinary word suggestive of the identified services. As a result, when confronted with Applicant’s and Registrant’s marks, prospective consumers will glean different meanings and assume that the respective services originate from different sources.

Again, any of the *DuPont* factors may play a dominant role. *DuPont*, 177 USPQ at 567. As noted above, in some cases, a single factor may be dispositive. *Kellogg v. Pack'em*, 21 USPQ2d 1142. In the present ex parte appeals, the record evidence shows that the dissimilarity of the marks in meaning and commercial impression are so great as to outweigh the other *DuPont* factors, discussed above. For that reason, we find the first *DuPont* factor to be pivotal, and the Examining Attorney's Section 2(d) refusals are reversed.

Decision: The Section 2(d) refusals to register Applicant's standard and composite marks are reversed.